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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

PM92/0720

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ART UNIT

PAPER NUMBER

3634

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DATE MAILED:

07/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/205,318

Applicant(s)
Lapage et al

Examiner
Blair M. Johnson

Art Unit
3634



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19 is/are allowed.
- 6) ☒ Claim(s) 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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1. Claims 20-27 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

There appears to be three features, which are related, which appear in the patented claims and have been modified or removed from new claims 20-27. The first feature involves the preamble of patent claim 1 which recites a closure device "typically for use on vehicle shelters". However, the Examiner made in clear in his action of 11-17-95 (first and only office action) that he considered the invention to be directed only to the closure and that the vehicle shelter was not being claimed. Applicant has omitted this functional recitation from the new claims. Since the Examiner did not view this functional recitation as limiting, the omission of this feature now does not constitute an attempt to recapture. However, Applicant uses this feature as a reason for his originally claiming of the second and third features, namely the diverging sides of the closure and

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the diverging guide means, both of which are clearly claimed in claim 1 of the patent. The question to be asked regarding the issue of recapture is: Were these limitations of the diverging sides and guide means necessary for patentability? Upon reading Applicant's remarks beginning on page 5 of Applicant's response of 5-30-96 (first and only response), it is clear that the "diverging" feature is at the point of novelty. (Note that on page 5, Applicant appears to agree with the Examiner that the vehicle shelter is not being recited when he states that certain amendments to claim 1 were made to "remove therefrom any limitation of the claimed closure device related to the vehicle shelter". Further, nowhere in his address of the prior art, none of which deals with vehicle shelters, does he argue the shortcomings of the prior art due to this lack of environmental teaching.)

Regarding the Belgian patent to Wellens, he states on page 6, lines 13-15, that "In the present invention, the section closing the trapezoidal opening is complementary in shape thereto and thus cannot be fairly compared to the Wellens system", the Wellens system which includes a screen which is "*vertically* guided along guide tracks", page 6, line 1, emphasis **not** added. He further states: "In fact, Claim 1 is considered to clearly distinguish from the Belgium Patent by claiming that the section of the flexible closure closing the shelter opening has side edges tapering towards the overhead roller provided at the narrow end of the shelter opening", page 6, lines 15-19. This is a clear indication that Applicant fully considered that the "diverging" feature rendered his claim allowable.

Regarding Applicant's remarks concerning both Ojima et al and German patent

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No. DE-38 41 139-A1 further stress the importance of the “diverging” feature to overall patentability by stating that while these references do have diverging sides and guides, they differ in other structural ways, i.e. location of the roller. He states on page 7, lines 6-8, that these two references show the roller at the “large end of a trapezoidal opening as opposed to the device of the present invention which is, and must, be installed at the narrow end thereof”, emphasis **not** added. Again, emphasis is put on the patentability of the “diverging” feature.

Regarding Germann, he again states that the closure is a “constant span”, emphasis **not** added, and also addresses the “large” end verses the “narrow” end of the opening, as discussed above.

On page 8, Applicant summarizes his view of the patentability of claim 1 over the prior art as being attributable to the “tapering section”, the prior art having “rectangular” closures, etc.

Consequently, it is clear from the specifics discussed above, as well as from the general view expressed by Applicant in the remarks of 5-30-96, that the diverging sides of the closure and the diverging guide means are the primary, and essentially only, feature which renders the claims allowable. Removing these features from the claims would be an attempt to recapture claimed subject matter.

2. Claims 20-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claims 20 and 26, the closure device is said to be "disposed adjacent a door opening", suggesting that the door opening has been claimed. However, later in the claim, the roller is said to be "adapted" to be mounted adjacent the door opening, suggesting that the door has not been recited. The scope of the claim is therefore indefinite.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelly Co. RT series catalog, Tufflex Beam (TM).

The Tufflex beam is stated as being resilient.

5. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Coenraets.

The spring 5 is in compression, column 2, line 57, and exerts a force on the tracks and hence the closure, column 2, lines 56-62.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraeutler '902.

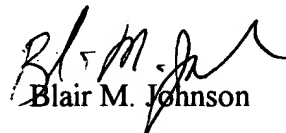
In Fig. 3, straps 102 are disclosed which are of polyester material which is inherently resilient, to at least a minimum extent.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Belgian patent No. 533251 (Wellens) in view of either Tufflex Beam or Kraeutler '902.

Wellens discloses everything except the elastic, or resilient, member. However, both Tufflex and '902 disclose such a feature which allows flexing and returning to form of the leading edge member of the roller closure so as to prevent breaking thereof. In view of this teaching, it would have been obvious to modify the bottom member 16 to be elastic.

9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coenraets in view of either Tufflex Beam or Kraeutler '902.

Coenraets discloses everything, including blocks 2', except the elastic, or resilient, member. However, both Tufflex and '902 provide a elastic reinforcing member which is designed to flex, as does the curtain of Coenraets. In view of this teaching, it would have been obvious to modify Coenraets whereby he has a elastic reinforcing member at the leading edge of his closure.


Blair M. Johnson

Primary Examiner
Art Unit 3634

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